

Remarks

It appears that the only outstanding rejection is the rejection under 35 USC 112 that there is no support in the specification as originally drafted for the limitation that the films are free of B and P.

The intention of the applicants in the previous response was to limit the claims to the embodiments wherein B and P were absent in the films. The Examiner was correct with regard to claim 20 in that it inappropriately referred to modifiers (P and B) excluded by the base claims. Accordingly claim 20 (and claim 19) has been canceled by this amendment, although of course the claims as currently worded do not preclude the use of modifiers other than B and P.

The rejection under 35 USC 112 with respect to claims 1 and 21, and the claims dependent thereon is respectfully traversed.

The passage referred to on page 28, line 29, makes it unambiguously clear that the novel PECVD approach in accordance with the invention does not require the use of B and/or P. There is no qualification that the use of B and/or P must applied as a gas as suggested by the Examiner. The specification states that the PECVD "approach" does not "require the use" of B and/or P, and indeed in the embodiment disclosed B and P are not employed. Thus, one disclosed embodiment of the invention can be considered to be the deposition without any qualification of a film that does not involve the "use" of B and P. Since the PECVD forms the film, as taught by the invention, it inevitably follows that result of forming a film by PECVD without the use of B and P will result in a film free of B and P.

It follows that the applicants have clearly disclosed in the original specification an embodiment of the invention wherein the film is free of B and P.

The passage on page 33 states that modifiers may be added to modify the refractive index of the films, such modifiers including B and P. Contrary to the position taken by the Examiner, this passage provides further support for the proposition that embodiments are disclosed wherein no such modifiers are added, consistent with the statement on page 28 since the word *may* implies that some embodiments, envisaged by this paragraph, exist wherein modifiers are added. These, however, are different embodiments.

In summary, there is a clear and unambiguous disclosure in the original specification of two different embodiments of the invention:

1. Embodiments wherein B and P are absent (Their use is not “required”).
2. Embodiments wherein B and P are added as modifiers to change the refractive index.

It has long been the case that the applicant has been entitled to limit his claims to one or a subgroup of the embodiments originally disclosed. That is all the applicant has done in the present situation. The applicant has elected to limit his invention to the embodiments wherein B and P are absent. Such a limitation does not give rise to an objection under 35 USC 112.

The applicants elected to limit to this embodiment in part to overcome a reference, Bouffard, which might be termed “accidental” in the sense that it has nothing whatsoever to do with the problem addressed by the invention. The teachings of the reference would be meaningless in the absence of B and P and therefore Bouffard has no application to a method of making films that does not require the use of B and P.

Moreover, it is respectfully submitted that the Examiner’s position is inconsistent with MPEP 2173.05(i), which deals with negative limitations.


Any negative limitation or exclusionary proviso must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff’d mem.*, 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. *Note that a lack of literal basis in the specification for a negative limitation may not be sufficient to establish a prima facie case for lack of descriptive support.* *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993). (emphasis added)

In the present case, the applicants have clearly recited alternative “elements” (in this case embodiments), namely embodiments wherein B and P are not present, and embodiments where they are present. See *In re Johnson supra*.

The MPEP states that the “mere absence of a positive recitation is not the basis for an exclusion”. Thus, contrary to the situation at hand, the applicants submit that if the specification were merely silent as to the presence of B and P, the addition of the negative limitation would be objectionable, and the Examiner’s rejection would have merit. But that is not the case here. The applicant clearly envisaged the two alternative scenarios noted above, and according to the caselaw as summarized in the MPEP is permitted to limit the claims to one of the alternatives disclosed by including the negative limitation without offending 35 USC 112.

Reconsideration and allowance are thus respectfully requested.

Respectfully submitted,



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